

REMARKS

This Amendment is submitted in response to the Office Action mailed on February 18, 2010. Claims 1, 9, 13 and 18 have been amended, and claims 8 and 17 have been canceled without prejudice or disclaimer. Claims 1, 2, 4-7, 9-16 and 18-20 remain pending in the present application. Applicants note and appreciate Examiner's allowance of claims 1, 2 and 4-8. Applicants' counsel appreciates the courtesy extended by Examiner Evans during the telephone interview conducted on even date herewith. In view of the foregoing amendments, as well as the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and request reconsideration of the application in this regard.

Claims 9-17 and 18 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wrba et al., WO 00/18525 ("Wrba et al.") in view of Opdyke ("Opdyke"), U.S. Patent No. 5,331,131. Lastly, claims 19 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wrba et al. in view of Opdyke and further in view of Sako et al., Japan Patent No. 11-170,077.

In accordance with the discussion held with Examiner Evans during the telephone interview conducted on even date herewith, Applicants have amended independent claim 1 and dependent claim 9 as suggested by Examiner to overcome the rejection of claim 9 under 35 U.S.C. §112, second paragraph. Support for the

amendment made to claim 9 is provided at Page 3, lines 23-26 of Applicants' disclosure, for example.

As discussed during the telephone interview, independent claim 1 recites that the side walls of the swage are treated by means of a laser beam and/or a processing means after several layers have been removed. Since independent claim 1 is not limited to treatment of the side walls of the swage solely by means of a laser beam but further recites treatment of the side walls in combination or in the alternative with a "processing means," claim 9 is indeed definite since it recites various combinations or alternatives for the "processing means." In view of the above, and as agreed during the telephone interview, the rejections of claim 9, and claims 10-16 depending therefrom, should be withdrawn.

With respect to the rejections of claims 18-20 under 35 U.S.C. §112, second paragraph, Applicants have amended claim 18 to recast it solely as an apparatus claim. Consequently, the Examiner's rejections of claims 18-20 under 35 U.S.C. §112, second paragraph, should be withdrawn.

With respect to the rejection of independent claim 18 as being unpatentable over Wrba et al. in view of Opdyke, Applicants submit that the combination of Wrba et al. and Opdyke fails to fairly teach or suggest the combination of elements recited in independent claim 18, including a processing means and a feeding means for the processing means, wherein the control means is configured to drive the laser treatment means or the feeding means for the processing means for

treating the side wall of the swage such that a plurality of layers of material is removed and then the side wall is treated.

As previously argued by Applicants, Wrba et al. is directed to forming a hollow or swage in a workpiece by removing material in a layer-wise manner. Wrba et al. is completely silent with respect to treating side walls of the swage after several layers have been removed as recited in amended independent claim 18.

Opdyke is directed to a laser ablation technique for manufacturing contact lenses having a desired lens shape. In the ablation technique of Opdyke, debris and accumulation on the target surface is reduced by scanning the laser beam beginning at a point on the target surface where the least amount of material is to be removed and the least amount of debris will be formed. The laser beam is then directed toward the point at which the greatest amount of material is to be removed to create the final surface. See Col. 3, lines 28-33 and Col. 4, lines 21-30. So, in the ablation technique of Opdyke, there are no side walls of the swage that are treated by a laser beam after several layers have been removed. Rather, the ablation technique of Opdyke ablates the redepositions as a laser is scanned to form the desired lens shape.

Accordingly, Applicants respectfully submit that the combination of Wrba et al. and Opdyke fails to achieve Applicants' claimed invention as recited in amended independent claim 18 and the rejection of this claim should be withdrawn.

As claims 9-16, 19 and 20 depend from allowable independent claims 1 and 18, and further as each of these claims recites a combination of elements or steps

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not fairly taught or suggested by the prior art of record, Applicants submit that these claims are allowable as well.

Moreover, as withdrawn claims 21-25 depend from allowable independent claim 18, these claims should now be rejoined in the present application and are submitted to be allowable.

CONCLUSION


In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this affect is earnestly solicited. If there is any issue that remains which may be resolved by telephone conference, Examiner is invited to contact the undersigned in order to resolve the same and expedite the allowance of this application.

Applicants do not believe that this response requires that any fees be submitted, however, if any fees are deemed necessary, these may be charged to Deposit Account No. 23-3000.

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Respectfully submitted,

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